

REMARKS

Claims 1-8, 11, 13, and 15 are now pending in this application for which applicant seeks reconsideration.

Amendment

Claims 1-8, 11, 13, and 15 have been amended in order to improve their readability. Claim 13 has also been amended in order to overcome the rejection under 35 U.S.C. §101. Claims 9-10, 12, 14, and 16 have been cancelled.

Subject Matter Rejection

Claims 1-8, 11, and 13-15 stand rejected under 35 U.S.C. §101 as being directed toward non-statutory subject matter.

Regarding claims 1 and 15, the examiner asserts that the claimed registration permitting/inhibiting deciding module fails to produce a tangible result, and is therefore non-statutory. Applicant strongly disagrees. Applicant notes that the USPTO's own Interim Guidelines for Subject Matter Eligibility, posted on the USPTO website on October 26, 2005, invalidate this line of reasoning. In that document, the USPTO allows for a useful, concrete, and tangible result to "flow inherently" from a claim. Applicant notes that the claim language relating to the registration permitting/inhibiting deciding module clearly implies a tangible result, i.e. the "permitting" and inherent registration of a word. Additionally, applicant emphasizes that the claimed registration module inherently must register something. Third and finally, applicant notes that even the claimed inhibiting part of the registration permitting/inhibiting deciding module produces a tangible result, namely, the elimination of unnecessary words in the search index.

Regarding claim 11, the examiner asserts that the claim is non-statutory because it is a method that can be performed by an electro-optical device or entirely as a series of mental steps. Applicant strongly disagrees. Applicant notes that the USPTO's own Interim Guidelines for Subject Matter Eligibility invalidate this line of reasoning. In that document, the USPTO requires that "examiners must still determine whether the claimed process produces a useful, concrete, and tangible result," even if it is entirely the result of mental steps. Regarding this claim, the examiner has made no argument with regard to how the claim fails to produce a useful, concrete, and tangible result. Hence, the rejection is not even proper. Applicant submits that the arguments above with respect to claims 1 and 15 also apply to claim 11 with regard to

producing a useful, concrete, and tangible result. Further, applicant notes that the claim recites a determination step of determining if a document is a “recognition processed document,” which in light of the specification clearly refers to an Optical Character Recognition (OCR) document. Such an OCR document only has meaning to a machine, not a human.

Accordingly, applicant respectfully requests that the rejection under 35 U.S.C. §101 be withdrawn.

Art Rejection

Claims 1-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Morton et al. (U.S. Pub. 2005/0216443) in view of Yasujima et al. (U.S. Pat. 4,944,022.) The examiner contends that Morton discloses all the elements of the claimed invention, except for the unknown word extracting device that extracts an unknown word. The examiner further contends that Yasujima discloses this element of the claim and it would be obvious to modify Morton in view of Yasujima to arrive at the claimed invention. Applicant strongly disagrees.

Regarding claims 1, 11, 13, and 15, applicant submits that the examiner’s proposed combination fails to yield the claimed invention. Specifically, neither Morton et al. nor Yasujima et al. disclose “an unknown word extracting device that extracts an unknown word which is not in a dictionary from the document being searched,” as presently claimed. The unknown word refers to a word which cannot be found in a dictionary and not to a word which has yet to be optically recognized, as the examiner appears to have interpreted the claim. Hence, Yasujima et al. does not disclose this element of the claim since it merely discloses a character-by-character optical recognition, and makes no mention of extracting an unknown word which is not in a dictionary.

Further, Morton et al. and Yasujima et al. fail to disclose “a registration permitting/inhibiting deciding device that decides, when the type of the document being searched is the recognition processed document, to inhibit said index information registering device from registering as the index information the unknown word extracted from the document being searched by said unknown word extracting device,” as presently claimed. The passages of Morton et al. cited by the examiner simply describe an indexing feature of a search program. Nowhere does Morton et al. disclose a “permitting/inhibiting deciding device” that inhibits the registration of an unknown word that originates from a recognition processed document. Therefore, applicant respectfully requests that the rejection under 35 U.S.C. §103 be withdrawn.

Conclusion

Applicant submits that claims 1-8, 11, 13, and 15 patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicant urges the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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